

REMARKS

As a preliminary matter, Applicants appreciate the Examiner's indication that dependent Claims 3, 4, 36 and 37 contain allowable subject matter, and would be allowed if amended into independent form to include the subject matter of their associated independent claims and any intervening claims. In response, Applicants have amended Claims 3 and 36 into independent form, and respectfully request an indication of the allowance of Claims 3 and 36 and associated dependent Claims 4 and 37.

With regard to the restriction requirement, although Applicants have cancelled non-elected Claims 11-29 in order to expedite prosecution, Applicants once again submit that the Examiner's rationale for the restriction requirement is improper, and if the restriction requirement is withdrawn, Applicants will reinstate the subject matter of cancelled Claims 11-29. As previously argued, the Examiner has failed to provide a valid example of a product not defined within the claims that recite the method. More specifically, the Examiner asserted that the method of Claims 11-29 "can be practiced by a device other than a sizing member without a stylus, such as [by a device] with a sensor." However, dependent method Claims 19 and 29 recite a stylus. Thus, it is impossible to practice the claimed method of these claims without a stylus because a stylus is recited in these claims. Accordingly, Applicants once again request that the Examiner withdraw the restriction requirement because the Examiner has not shown that the *claimed* process of using can be practiced with another materially different product, i.e., a product not defined in the claimed process. See MPEP §806.05(h).

Claims 1, 2, 5-8, 30-32, 34 and 38-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,486,178 to Hodge. Claims 32 and 40 have been cancelled, without prejudice, thereby rendering this rejection moot with respect to these claims. However, with respect to Claims 1, 2, 5-8, 30, 31, 38 and 39, Applicants respectfully traverse this rejection.

Applicants respectfully submit that Hodge fails to disclose all of the features of the present invention. In particular, Hodge fails to disclose the sizing guide of independent Claim 1 that includes, *inter alia*, a stylus member with at least one arm with a pin thereon, wherein “the pin is positioned at a fixed distance from a point of attachment between the stylus member and the sizing block.” Additionally, Hodge fails to disclose the sizing guide of independent Claim 30 that includes, *inter alia*, a sizing block “mounted to a distal cut surface of a femur.” Finally, Hodge fails to disclose the system of Claim 38 including, *inter alia*, a means for utilizing a sizing guide that is “rotatable about an axis that passes through the means for mounting.”

With regard to independent Claim 1, one example of an embodiment that includes the feature defined by the language “the pin is positioned at a fixed distance from a point of attachment between the stylus member and the sizing block” is shown in Applicants’ Figure 4, which shows how each of the pins 132, 134 and 136 are positioned at a fixed distance from a point of attachment (the axis extending through opening 84) between stylus member 64 and sizing block 62. This relationship is maintained even when stylus member 64 is rotated about the axis because the axis is coincident with the point of attachment. It

should be noted that although three pins (132, 134, 136) and three arms (126, 128, 130) are shown in the Figure 4 embodiment, Claim 1 is satisfied by a single arm with a pin thereon due to the language “at least one arm.”

In contrast, Hodge does not include a pin that “is positioned at a fixed distance from a point of attachment between the stylus member and the sizing block,” as defined in Applicants’ Claim 1. As shown in Figure 3 of Hodge, the distance between pin 90 and the point of attachment between stylus assembly 80 and sizing guide block 40 is variable due to the pivot point near end 86 of arm 84. Accordingly, as all of the features of Claim 1 are not disclosed in Hodge, Applicants respectfully request the withdrawal of this §102 rejection of independent Claim 1 and associated dependent Claims 2 and 5-10 under Hodge.

With regard to independent Claim 30, Applicants’ Figure 2 shows one example of an embodiment that includes the feature defined by the language “a sizing block mounted to a distal cut surface of a femur.” More specifically, Figure 2 shows sizing block 50 mounted to distal cut surface 26 of femur 20.

In contrast, the device of Hodge is mounted to an *uncut* distal end of a femur, and in fact, the cutting guide is attached to the sizing guide block prior to making the distal cut. More specifically, Figure 2 of Hodge shows how sizing guide block 40 is attached to an uncut distal end of femur 10. Further, Figures 4 and 5 of Hodge show how a cutting guide 120 can be attached to sizing guide block 40 prior to attaching the cutting guide 120 to the femur 10, whereby the sizing guide block 40 is removed after pins 124 are inserted, and then the distal femur cut is made by blade 130 (Figure 5). Thus, sizing guide block 40 of Hodge is

not “mounted to a distal cut surface of a femur,” regardless of whether it is being used with stylus assembly 80 or with cutting guide 120. Accordingly, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 30 and associated dependent Claims 31 and 33-35 under Hodge.

With regard to independent Claim 38, Applicants’ Figure 4 shows one example of an embodiment that includes the feature defined by the language “a stylus that is rotatable about an axis that passes through the means for mounting.” More specifically, Figure 4 shows stylus member 64 that is rotatable about an axis that passes through a hole 84 in the sizing block 62 (one example of a “means for mounting”). In contrast, as shown in Figure 3 of Hodge, stylus assembly 80 slides within guide block 40, and is not rotatable about an axis that passes through the guide block. Accordingly, as all of the features of Claim 38 are not disclosed in Hodge, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 38 and associated dependent Claim 39 under Hodge.

Claims 1, 6, 8-10, 30, 32, 33, 35, 38 and 39 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,662,656 to White. Claim 32 has been cancelled, without prejudice, thereby rendering this rejection moot with respect to this claim. However, with respect to Claims 1, 6, 8-10, 30, 33, 35, 38 and 39, Applicants respectfully traverse this rejection.

Applicants respectfully submit that White fails to disclose all of the claimed features of the present invention. In particular, White fails to disclose the sizing guide of independent Claim 1 that includes, *inter alia*, a stylus member with at least one arm with a

pin thereon, wherein “the pin is positioned at a fixed distance from a point of attachment between the stylus member and the sizing block.” Additionally, White fails to disclose the sizing guide of independent Claim 30 that includes, *inter alia*, a sizing block “mounted to a distal cut surface of a femur.” Similarly, White fails to disclose the system of Claim 38 including, *inter alia*, a means for mounting a sizing guide proximate “a distal cut surface of a femur.”

With regard to independent Claim 1, White does not include a pin that “is positioned at a fixed distance from a point of attachment between the stylus member and the sizing block.” As shown in Figure 11 of White, the distance between pointed end 95 (which is the feature that most closely resembles the claimed pin) and its point of attachment to head 99 is variable because stylus 93 is intended to slide within aperture 101. Accordingly, as all of the features of independent Claim 1 are not disclosed in White, Applicants respectfully request the withdrawal of this §102 rejection of independent Claim 1 and associated dependent Claims 6 and 8-10.

With regard to independent Claims 30 and 38, White fails to disclose a sizing block or a means for mounting a sizing guide that is mounted to a “distal cut surface” of a femur. In contrast, as shown in Figure 11 of White, member 47 is mounted to an *uncut* distal end of femur 13. Accordingly, as all of the features of independent Claims 30 and 38 are not disclosed in White, Applicants respectfully request the withdrawal of this §102 rejection of independent Claims 30 and 38 and associated dependent Claims 33, 35 and 39 under White.

Claims 1, 5-7, and 30 stand rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,458,135 to Harwin et al. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Harwin et al. reference fails to disclose all of the claimed features of the present invention. In particular, the Harwin et al. reference fails to disclose the sizing guide of independent Claim 1 that includes, *inter alia*, a stylus member with at least one arm with a pin thereon, wherein “the pin is positioned at a fixed distance from a point of attachment between the stylus member and the sizing block.” Additionally, the Harwin et al. reference fails to disclose the sizing guide of independent Claim 30 that includes, *inter alia*, a sizing block with “an opening for slidably receiving a rod extending from the femoral canal.”

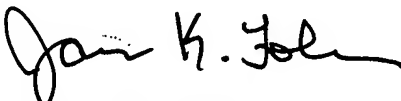
With regard to independent Claim 1, the Harwin et al. reference does not include a pin that “is positioned at a fixed distance from a point of attachment between the stylus member and the sizing block.” As shown in Figure 3 of the Harwin et al. reference, the distance between vertical member 86 (which is the feature that most closely resembles the claimed pin) and its point of attachment to block 32 is variable because stylus 80 is intended to slide within the slot on post 90, as indicated by double-headed arrow 88. Accordingly, as all of the features of independent Claim 1 are not disclosed in the Harwin et al. reference, Applicants respectfully request the withdrawal of this §102 rejection of independent Claim 1 and associated dependent Claims 5-7.

With regard to Claim 30, member 32 of the Harwin et al. reference fails to include "an opening for slidably receiving a rod extending from the femoral canal." In contrast, the device of the Harwin et al. reference includes no such aperture for receiving a rod from the femoral canal. Accordingly, as all of the features of independent Claim 30 are not disclosed in the Harwin et al. reference, Applicants respectfully request the withdrawal of this §102 rejection of independent Claim 30.

For all of the above reasons, Applicants request reconsideration and allowance of the claimed invention. Should the Examiner be of the opinion that a telephone conference would aid in the prosecution of the application, or that outstanding issues exist, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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